

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of :

Joseph C. Walsh

Serial No.: 10/027,744

Filed: December 20, 2001

For: PROCESS FOR MAKING A
DISPENSING ASSEMBLY

)
) Group Art Unit: 3721
) Examiner: Sameh H. Tawfik
) Atty Dkt. PP 5.71(c)
)

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FEB 03 2004

OFFICIAL

REQUEST FOR WITHDRAWAL OF FINALITY

To: Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Applicant respectfully requests that the finality of the Office action mailed January 30, 2004, be withdrawn for the reasons set forth below.

In the Office action, the Examiner applies new grounds of rejection to all of the pending claims. The Examiner provides the following explanation for nevertheless making the action final:

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §609(B)(2)(i).

(bold type in original)

The Examiner's statement appears to be in error since none of the new references applied by the Examiner in the final Office action were cited

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

on applicant's information disclosure statement. Specifically, the Examiner applies Goldstein (U.S. 2,701,679) and Knauf (U.S. 5,415,910) to reject applicant's claims. Applicant's information disclosure statement filed October 10, 2004, however, cites only Ours et al. (U.S. 6,474,046) and Ours et al. (U.S. 6,474,040). Accordingly, it is not seen how applicant's submission of the information disclosure statement in question could possibly have "prompted the new ground(s) of rejection" as asserted by the Examiner.

The Examiner's reliance on MPEP §609(B)(2)(i) is also not understood. This section of the MPEP reads as follows:

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.

(emphasis added)

At the outset, this section of the MPEP applies *only* to situations in which information cited by applicant is *used* in a new ground of rejection. As pointed out above, however, the Examiner did not use either of the references cited by applicant in the final rejection. Further, MPEP §609(B)(2)(i) only specifies a situation in which an Office action *will not be made final*; accordingly, this section cannot serve as the basis for making an action final.

It is noted that MPEP §609(B)(2)(ii) does authorize a final Office action in certain circumstances; once again, however, this section is relevant *only* when the reference cited is *used* in a new ground of rejection.

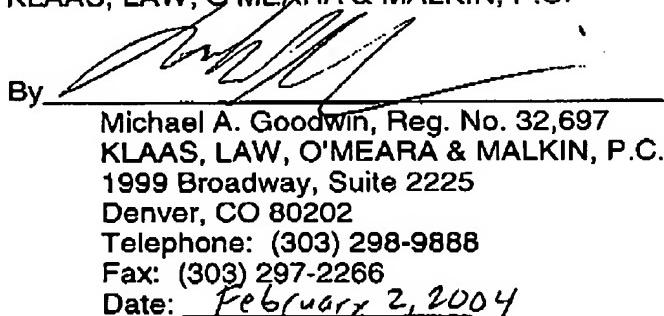
S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

For the reasons set forth above, applicant respectfully asserts that the Office action mailed January 30, 2004, was improperly made final.
Accordingly, applicant requests that the finality be withdrawn.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By


Michael A. Goodwin, Reg. No. 32,697
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Date: February 2, 2004

Page 3 of 3

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OFFICIAL**DATE:** February 3, 2004**TIME:** 1:10 pm**PLEASE DELIVER THE FOLLOWING PAGES TO:**

NAME: Examiner Sameh H. Tawfik **FAX NO.:** (703) 872-9306
 Group Art Unit 3721

LOCATION: U.S. Patent and Trademark Office**FROM:** Michael A. Goodwin, Esq. - KLAAS, LAW, O'MEARA & MALKIN, P.C.

RE: U.S. Patent Application Serial No. 10/027,744
 Our Ref.: PP 5.71(c)

TOTAL NO. OF PAGES (Including Transmittal Sheet) -7-**IF YOU DO NOT RECEIVE ALL PAGES, PLEASE CALL IMMEDIATELY.**

OFFICE: (303) 298-9888 **FAX:** (303) 297-2266

COMMENTS: Please find attached the following documents: Transmittal Form, Fee Transmittal for FY 2004 (in duplicate) and Request for Withdrawal of Finality (3 pages).

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PTO/SB/21 (05-03)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/027,744	
	Filing Date	December 20, 2001	
	First Named Inventor	Joseph C. Walsh	
	Art Unit	3721	
	Examiner Name	Sameh H. Tawfik	
Total Number of Pages in This Submission	6	Attorney Docket Number	PP S.71(c)

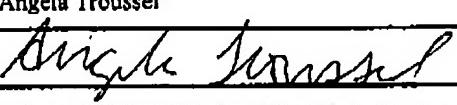
ENCLOSURES (Check all that apply)			
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter Other Enclosure(s) (please identify below):	
Remarks			

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Michael A. Goodwin, Esq.
Signature	
Date	February 3, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office to Fax No. 703-872-9306 on the date shown below.

Typed or Printed Name	Angela Troussel
Signature	
Date	February 3, 2004

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/17 (10-03)

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FEE TRANSMITTAL

for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)-0-

Complete If Known

Application Number	10/027,744
Filing Date	December 20, 2001
First Named Inventor	Joseph C. Walsh
Examiner Name	Sameh H. Tawfik
Art Unit	3721
Attorney Docket No.	PP 5.71(c)

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number	11-1150
Deposit Account Name	Klaas, Law, O'Meara & Malkin, P.C.

The Director is authorized to: (check all that apply)

- Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code (\$)	Fee	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	285	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)			(\$)-0-		

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Extra Claims	Fee from below	Fee Paid
16	-75** = 0		X \$18.00	
2	-19** = 0		X \$86.00	

Large Entity : Small Entity

Fee Code (\$)	Fee	Fee Code (\$)	Fee Description
1202	18	2202	9 Claims in excess of 20
1201	88	2201	43 Independent claims in excess of 3
1203	290	2203	145 Multiple dependent claim, if not paid
1204	86	2204	43 ** Reissue independent claims over original patent
1205	18	2205	9 ** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2)		(\$)-0-	

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Code (\$)	Fee	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	26	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	800	Request for expedited examination of a design application	
Other fee (specify)					
*Reduced by Basic Filing Fee Paid				SUBTOTAL (3)	(\$)-0-

(Complete if applicable)

Name (Print/Type)	Michael A. Goodwin, Esq.	Registration No. /Attorney/Agent	32,697	Telephone	(303) 298-9888
Signature				Date	February 3, 2004

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